

## **REMARKS**

Claims 1-6, 8-17, 38-41 and 51-52 are pending in the application, and claims 7, 18-37, 41-50 and 53 have been cancelled without prejudice. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments contained herein.

## **REJECTION UNDER 35 U.S.C. § 102**

Claims 1-6, 8-17, 33-35 and 38-41 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Burnside et al. (U.S. Pat. No. 6,237,604). This rejection is respectfully traversed.

### **Independent Claim 1**

The Applicant submits that Burnside does not anticipate an interface that provides actuation instructions to the navigation device for controlling the distal end of the device, which instructions take into account the physical and geometric properties of the elongate medical device obtained from the electronic identification device.

The Office Action states on page 3 (lines 10-12) that Burnside's electronic identification device includes information on the physical properties of the medical device. However, Burnside's mere singular reference at Column 2, line 24 to a "physical characteristic of the probe" does not teach or suggest providing instructions take into account the physical and geometric properties of the elongate medical device obtained from the electronic identification device. Rather, Burnside's sole teaching is that of verifying identification information of the probe to determine whether the medical probe should not be operated. (Burnside, Column 2, lines 26-29).

Not only does Burnside fail to teach providing instructions that take into account the physical and geometric properties of a medical device obtained from an electronic identification component, Burnside does not enable any instructions for controlling the distal end of the device that take into account physical and geometric properties of a medical device. For a prior art reference to anticipate the claimed invention, the reference must enable a person of ordinary skill in the art to produce the claimed invention without undue experimentation. *In re Paulsen*, 30 F.3d 1475, (Fed. Cir. 1994).

The present specification states that when the medical device is plugged into the workstation computer...the associated device properties information is communicated to the workstation computer, where the properties may include quantities unique to the device that are essential for navigational control, such as the length of flexible device segments, elastic properties, cross-sectional details, magnet dimensions and the type of magnet. (paragraph 24 of the specification). A navigational control algorithm determines a set of actuation control variables  $\{u\}$  that drive the device towards a user-specified target, where a functional relationship  $f$  of the control variable is based on the physics model of the flexible device. (paragraphs 30 - 31). Based on the claimed feature of providing instructions that take into account the devices physical properties, the Applicant submits claim 1 is distinguished from and not anticipated by Burnside.

#### Independent Claim 38

At the outset, the Applicant submits that the amendments to claim 38 have rendered the above rejections moot. Claim 38 has been amended to include the features of claims 49 and 50, which both successively depend from Claim 38.

Claim 38 as amended clarifies that the medical device has a memory that includes information on the devices physical and geometric properties that are relevant to navigational control of the device, wherein the physical and geometric properties of the device are used in navigational control algorithms for guiding the device.

As noted above, Burnside fails to teach or enable providing a medical device having a memory device including information on the device's physical and geometric properties, and an interface for sending actuation instructions to a navigational control system, wherein the physical and geometric properties of the device are used in navigational control algorithms for guiding the device. Based on the claimed feature of providing instructions in which the device's physical properties stored in a memory are used in navigational control algorithms for guiding the device, the Applicant submits claim 1 is distinguished from and not anticipated by Burnside. As such, the Applicant submits that claims 1 and 38, and claims 2-6, 8-17, 39-40 and 51-52 which ultimately depend from independent claims 1 and 38, are allowable for at least these reasons.

#### **REJECTION UNDER 35 U.S.C. § 103**

Claims 23 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Burnside et al. (U.S. Pat. No. 6,237,604), and claims 24-25, 27, 29-30 and 52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Burnside et al. in view of Osadchy et al. (U.S. Pat. No. 6,266,551). This rejection is respectfully traversed.

The Applicant has cancelled claims 18-37 without prejudice, and reserves the right to resubmit or refile these claims at a later time or in a subsequent application.

### Claim 52

At the outset, the Applicant submits that Burnside fails to teach or enable providing an interface for sending actuation instructions that include information on the physical and geometric properties stored in a memory of the medical device, wherein the physical and geometric properties of the device are used in navigational control algorithms for guiding the device. Based on the above claimed features, the Applicant submits claim 38, from which claim 52 ultimately depends, is distinguished from and not anticipated by Burnside. Accordingly, the Applicant submits that claim 52 is patentable over the cited references for at least these reasons.

### **REJECTION UNDER 35 U.S.C. § 103**

Claim 51 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Burnside et al. (U.S. Pat. No. 6,237,604) in view of Osadchy et al. (U.S. Pat. No. 6,266,551) and in further view of Lee et al (U.S. Pat. No. 6,714,809). This rejection is respectfully traversed.

### Claim 51

The Applicant respectfully submits that Lee does not disclose or suggest a memory having information on the physical and geometric properties of the device that includes at least one of the length of one or more flexible segments of the device, one or more cross-sectional areas of the device, and an elastic property of the device. Rather, Lee only discloses that "The interface circuit may also include an identification system to identify the coil to the connector or to the scanner with a coding scheme". (Lee, Column 6 lines 24-26).

Thus, the Applicant believes that claim 51 is further distinguished from the cited references. As such, the Applicant submits that claim 51, which ultimately depends from independent claim 38, is also allowable for at least these reasons.

#### **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (314)-726-7500.

Respectfully submitted,

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